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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,225	02/27/2004	Richard J. Church	M 5796 PCT/US	7959
423 7590 01/25/2008 HENKEL CORPORATION 1001 TROUT BROOK CROSSING ROCKY HILL, CT 06067			EXAMINER ZHENG, LOIS L	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/789,225	CHURCH, RICHARD J.	
	Examiner	Art Unit	
	Lois Zheng	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 18-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1 and 6-7 are amended in view of applicant's claim amendments filed 6 November 2007. New claims 18-19 are added in view of applicant's amendments. Claims 15-17 are canceled in view of applicant's amendments. Therefore, claims 1-14 and 18-19 are currently under examination.

Status of Previous Rejections

2. Applicant's arguments, see applicant's remarks, filed 6 November 2007, with respect to Hacias (WO 98/23789) have been fully considered and are persuasive. The rejections of claims 1-14 has been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-14 and 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In this case, the instant specification uses exact numbers for the lower and upper limits of oxyethylated aliphatic alcohol and phosphate concentrations. The use of the word "about" in independent claim 1 broadens the scope of the oxyethylated aliphatic

alcohol and phosphate concentrations a little bit beyond the disclosed oxyethylated aliphatic alcohol and phosphate concentrations, which renders the claimed oxyethylated aliphatic alcohol and phosphate concentrations ranges new matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/12655, which corresponds to US Patent No. 6,472,352 B1 issued to Hacias(Hacias'352), in view of WO 98/23789, which corresponds to US Patent No. 6,068,710 issued to Hacias(Hacias'710), and further in view of King et al. US 4,289,547(King).

Hacias'352 teaches an aqueous metal surface lubricating coating to prepare metal surfaces for cold forming, wherein the lubricating coating composition comprising the claimed oxyethylated aliphatic alcohol with the claimed number of carbon atoms and the claimed at least 20% oxyethylene units, the claimed lithium, sodium and/or calcium salts of fatty acids with the claimed number of carbon atoms, wherein the ratio of the fatty acid to oxyethylated aliphatic alcohol is 0.02:1.0 to 2.0:1.0(col. 5 line 17 – col. 6 line3). Hacias'352 further teaches that the oxyethylated aliphatic alcohol is present in an amount of 1.0-15%(col. 5 lines 8-16). The coating solution of Hacias'352 further comprises the claimed inorganic boron containing compound, where the ratio of boron

and oxyethylated aliphatic alcohol is not less than 0.002:1.0(col. 6 lines 3-30), the claimed primary and secondary corrosion inhibitors(col. 7 line 34 – col. 8 line 20), the claimed surfactant and the claimed anti-foam agent(col. 3 lines 6-12). The pH of the coating solution is 3-11(col. 8 lines 31-36).

However, Hacias'352 does not explicitly teach the claimed phosphate anions.

Hacias'710 teaches an aqueous metal surface lubricating coating composition to prepare metal surfaces for cold forming(abstract, title), wherein the coating composition comprises at least 0.001 mol/l of phosphate ions(col. 3 lines 40-46). In addition, the coating composition of Hacias'710 comprises the same components as the coating solution of Hacias'352, such as inorganic boron containing compounds, primary and secondary corrosion inhibitors(abstract, col. 4 lines 1-64). The coating composition of Hacias'710 also has substantially the same pH as the coating composition of Hacias'352(col. 4 line 65 - col. 5 line 8). Hacias'710 further teaches that the treated metal surface can be coated with another lubricant composition comprising ethoxylated aliphatic alcohol(col. 6 line 62 - col. 7 line 26), the same oxyethylated aliphatic alcohol in the coating solution of Hacias'352.

King teaches a one step application of lubricating coating composition to prepare metal surfaces for cold forming, wherein both lubricating agent and conversion coating agent are both contained in lubricating coating solution and applied to the metal surface simultaneously(col. 1 lines 36-43, col. 2 lines 18-44). King further teaches that such a one-step application technique substantially reduces the treating time, plant space, capital cost and labor(col. 1 lines 27-33).

Regarding claim 1, it would have been obvious to one of ordinary skill in the art to have combined the coating compositions of Hacias'352 and Hacias'710 into a one-step coating solution as suggested by King, since the coating solution of Hacias'352 contains the organic lubricants and the coating solution of Hacias'710 contains the phosphate ions, in order to substantially reduces the treating time, plant space, capital cost and labor as suggested by King.

Regarding claims 2-3, 6-11 and 13-14, the oxyethylated aliphatic alcohol and the lithium salt of fatty acid meets the limitations of the instant claims.

Regarding claim 5, the phosphate ion concentration as taught by Hacias'352 in view of Hacias'710 and King overlaps the claimed phosphate ion concentration. Therefore, a prima facie case of obviousness exists. See MPEP 2144.05. The selection of claimed phosphate ion concentration range from the disclosed range of Hacias'352 in view of Hacias'710 and King would have been obvious to one skilled in the art since Hacias'352 in view of Hacias'710 and King teach the same utilities in the disclosed phosphate ion concentration range.

Regarding claims 12 and 18-19, Hacias'710 further teaches the addition of accelerators such as 1.2g/l m-nitrobenzene sulfonate or 1g/l of hydroxylamine sulfate (Table 1, comments of Test number 1.2 and 9.8). The remaining limitations in as recited in claim 18 is rejected for the same reasons as stated in the rejection of claims 1 and 7 above.

Response to Arguments

7. Applicant's arguments filed 6 November 2007 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LLZ


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